

Docket No: 3022-016
Applicants Ref: P02-0131US
Client No.: ARF-027US
File No.: 1227.42952X00

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	
	:	
H. TOYODA	:	
	:	Group: 3714
Serial No. 10/619,186	:	
	:	Examiner: Pandya, Sunit
Filed: July 15, 2003	:	
	:	
For: GAMING MACHINE, PROGRAM AND SERVER	:	

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 25, 2008

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed, concurrently with a Pre-Appeal Brief Request for Review, on May 9, 2008 and further to a Notice of Panel Decision from Pre-Appeal Brief Review issued on July 25, 2008 and the Advisory Action issued on April 23, 2008, responsive to the Request for Reconsideration filed on March 11, 2008, maintaining the rejection of all claims, as set forth in the final Official Action issued on December 13, 2007.

I. REAL PARTY IN INTEREST

Aruze Co. Ltd. has been assigned all rights in this application, as recorded at Reel 014794/Frame 0323. Accordingly, Aruze Co. Ltd. is the real party in interest.

II. RELATED PRIOR OR PENDING APPEALS, INTERFERENCES OR JUDICIAL PROCEEDINGS

None

III. STATUS OF CLAIMS

Claims 1-27 are pending. Each of claims 1-27 stands finally rejected and is under appeal.

IV. STATUS OF AMENDMENTS

No Amendments have been filed after issuance of the above referenced final Official Action. An Amendment filed prior to the final Official Action, which amended originally present claims 1-20 and added new claims 21-27, has been entered.

V. SUMMARY OF INVENTION

Overview

Each of independent claims 1, 3, 17, 19, and 20 requires the capability (i) to shift each allocated symbol of a peripheral group of cells of the matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells (see claims 1 and 3) or (ii) to shift each symbol allocated to a cell within or belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch (see claims 17 and 20), or (iii) to shift each symbol allocated to a cell belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to a user input (see claim 19).

Each of the independent claims also requires the capability to (i) make a disbursement related determination if all cells along a line become effective after a predetermined number of lotteries and the symbols allocated to the respective cells along the line make a winning combination, or (ii) make a cell effective if the symbol allocated to that cell matches the selected symbol, and make a disbursement related

determination if the cells along a line are made effective and the symbols allocated to the effective cells along the line make a winning combination. Thus, during play of a single game, the present invention has the capability of both shifting the symbols in the cells and making a disbursement based on whether or not the cells made effective after the shift contain a winning combination of symbols.

Stated another way, the limitations of the present claims require that there be (i) an allocation of symbols to cells, (ii) a shifting of the allocated symbols, (iii) a making effective of cells with allocated symbols by lottery and after the shifting, and (iv) a making of a disbursement if the cells along a line have a winning combination and have been made effective. That is unless and until a cell, in which a symbol is allocated, has been made effective during the play of the game, that symbol cannot form part of a winning combination.

As noted above, symbols are shifted (i) in response to operation of a switch according to claims 17 and 20, or (ii) in response to a user input according to claim 19.

Furthermore each of claims 17 and 20 requires a lottery selection unit for selecting a symbol by lottery after the shifting (step S14 of Fig. 14 and step S42 of Fig. 17), a collation unit for collating the selected symbol with the allocated symbols and for making a cell effective if the symbol allocated to that cell matches the selected symbol (step S43 of Fig. 17), and a disbursement unit for making a disbursement if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination (step S15 of Fig. 14 and Fig. 18).

Claim 19 requires selecting a symbol by lottery after the shifting, collating the selected symbol with the allocated symbols, making a cell effective if the symbol allocated to that cell matches the selected symbol, and making a disbursement if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination.

Thus, it should be noted that, in accordance with the present invention, a symbol serve two distinct purposes during the play of a game. First, it is used to determine

whether or not the cell to which it has been allocated will be effective during the game. Then, if the cell to which it has been allocated has been made effective, it is also used to determine whether a winning combination is formed.

As shown in Fig. 14, the preparation of a matrix is performed (step S12), and the setting of the betting quantity is performed (step S13). Further to the preparation, the game is executed (step S14), with a lottery selection of symbols (for making cells effective not for allocating symbols to cells) being performed a predetermined number of times. After the execution of the game, the payment of coins is performed (step S15).

As shown in Fig. 17, a lottery selection of a symbol is performed (step S42) as described on page 69 (for making cells effective not for allocating symbols to cells). In this process, one symbol is selected by an internal lottery. The selected symbol is then displayed in the list of lottery results displayed at the upper right part of display device 32, as shown in Fig. 11. If the selected symbol has already been selected once in the same game and is displayed in the above-mentioned list, the lottery result is not displayed a second time and the lottery is performed again so that a new symbol will be selected. Next, collation of the symbol is performed (step S43), as described in page 69. In this process, CPU 66 collates the above selected symbol with the symbols displayed in the matrix. If the same symbol as the selected symbol is displayed in the matrix, the cell in which the symbol is displayed is made effective and the color of this cell is changed, as shown in Fig. 11.

As shown in Fig. 18, a judgment is made as to whether or not there is a winning line (step S51) as described in pages 70-71. To do so, it is judged whether or not a line, in which all cells have been made effective and a winning combination is formed, exists among the combinations of symbols along the plurality of lines in the matrix displayed on display device 32. If it is judged that there is a winning line among the plurality of lines, a predetermined benefit is provided to the player.

According to the present invention, a new way of enjoying a game is provided, since the fun is not just in rearranging the symbols by shifting the symbols within the

cells to form a winning combination, but also in the anticipation of completing a line or highly-disbursed line of the cells which are already shifted. In addition, the fun of a “poker game” or “mahjong game” can also be enjoyed.

As shown in Fig.17, the determination of a prior effective cell is performed (step S41). To do so, a lottery is performed to determine a cell to be made effective from the start of the game, and the cell is made effective prior to the start of the game.

In accordance with the present invention, the positions of the symbols are determined in advance, unlike in the original “poker game”. So, there is the possibility that a large number of lotteries will be required to complete (i.e. make effective) a line. Thus, with the invention recited in some claims, some portion of the cells are made effective by a lottery in advance of the game, and this shortens the game time. Also a player can anticipate earlier completion of a line, thereby making it more likely to draw the interest of the player. In addition, because in the case where the designs of “mahjong tiles” are used, the number of cells can become large. The invention of claims 13-16 enables faster progress to be made in playing the game.

In the invention of some claims, the predetermined symbols forming at least one winning combination are allocated to the cells forming at least one line (and other symbols are allocated to other cells). As shown in Fig.15, a lottery selection of a winning combination is performed (step S21). In this process, one winning combination is selected from among a stored winning combination list. Next, the selection of symbols used in the determined winning combination is performed (step S22). Next, the line along which the determined winning combination is to be aligned is selected (step S23). For example, a lottery selection can be performed to determine the line among the twelve lines of the matrix. Furthermore, the allocating of the symbols that make up the determined winning combination is performed (step S24). To do so, it is determined by lotteries which cells along the line should be allocated which of the symbols, so that each cell along the line has a respective symbol.

In addition, as shown in Fig.15, allocation of symbols to the remaining cells is

performed (step S25). The symbols to be allocated to the remaining cells are also selected by lotteries, and the selected symbols are allocated to each of the remaining cells.

By carrying out the above, a plurality of matrices having at least one winning combination is easily prepared. In addition, it is possible to prevent a player from receiving a matrix with which a winning combination cannot be formed at all. Accordingly, the player can anticipate receiving a benefit.

In accordance with the invention of one claim, the shifting of the symbols in the outer peripheral cells is executed by operating a first switch, such as a switch corresponding to reference numeral 34 in the Figures, and the shifting of the symbols in the inner peripheral cells is executed by operating a second switch, such as a switch corresponding to reference numeral 36 in the Figures. (see, for example, page 55 and Figs. 8A-8C).

The present invention may be implemented to combine the fun of a “bingo game” (anticipating whether or not making effective a line of cells will be completed, with the cells being made effective in accordance with a lottery), the fun of a “poker game” or a “mahjong game” (anticipating whether or not a predetermined winning combination along a line will be completed, and changing the disbursement amount according to the winning combination), and the fun of a “puzzle game” (pondering how to shift the symbols in cells to form a winning combination and to receive high payout). Therefore, the present invention enables a new way of enjoying a game in which the aim is not just to complete any line among a plurality of lines, but in which a winning combination can be completed by rearranging the symbols in cells and a disbursed amount can be varied by the rearrangement of the symbols in the cells.

Concise Summary of Invention of Each Independent and Argued Dependent Claim

According to independent Claim 1, a gaming machine [having a CPU 66 and

those of the control programs described on pages 2, line 4, through 3, line 24, that are necessary for performance of the claimed functions see Figures 1 and 3, and page 59, lines 9-25] is provided with which a combination-making game is performed, the combination-making game using a matrix which comprises five rows and five columns so as to contain a plurality of cells, wherein a symbol is allocated to each cell, and a cell becomes effective when a symbol corresponding to the cell is selected randomly by a lottery, and a predetermined benefit is provided to a player based on a pattern of cells being effective after a predetermined number of lotteries [see Figures 7-8C, 11 and 12, and pages 52, line 26, through 54, line 18; and pages 56, line 27, through 58, line 1].

The gaming machine includes (1) a symbol allocation means for allocating a symbol to each cell of the matrix, the symbol being selected from a deck of playing cards [see Figure 15 (S21-S25), and pages 61, line 18, through 63, line 19]; (2) an outer peripheral cell shift means for shifting each allocated symbol of a peripheral group of cells of the matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells [see Figures 15 (S26) and 16 (S33), and pages 63, line 20, through 65, line 8, and pages 66, line 5, through 68, line 26]; and (3) a disbursement value determination means for determining an amount of disbursement or a multiple of a number of bets made by the player for disbursement depending on a predetermined rank of a combination of the combination-making game, if all cells along a line become effective after a predetermined number of lotteries and the symbols allocated to the respective cells along the line make a winning combination in a poker game [see Figures 17 and 18, and pages 69, line 2, through 73, line 25].

According to claim 2, an inner peripheral cell shift means for shifting each allocated symbol of an inner group of cells of the matrix from an inner original cell position to an inner adjacent cell position such that an inner loop of allocated symbols are shifted along the inner group of cells [see Figures 15 (S26) and 16 (S33), and pages 63, line 20, through 64, line 1, and pages 64, line 12, through 65, line 8, and pages 66,

line 5, through 68, line 26].

Independent claim 3 recites a gaming machine that is believed to also be described in the Figures and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 4, the game machine also includes an inner peripheral cell shift means for shifting each allocated symbol of an inner group of cells of the matrix from an inner original cell position to an inner adjacent cell position such that an inner loop of allocated symbols are shifted along the inner group of cells. These features and limitations are believe to also be described in the Figures and specification text referenced above with respect to claim 2, and according is not separately description to avoid unnecessary redundancy.

According to claim 5, the symbol allocation means allocates the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along the peripheral group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard. These features and limitations are believed to also be described in the Figures and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 8, the symbol allocation means allocates the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along at least one of the peripheral group of cells and the inner group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard. These features and limitations are believed to also be described in the Figures and specification text referenced above with respect to claims 1 and 2, and according is not separately description to avoid unnecessary redundancy.

According to claim 9, the gaming machine also includes a valid line determination means for determining a number and locations of lines of cells, with

respect to which disbursement of game media may be carried out if all cells aligned therein become effective. These features and limitations are believed to also be described in the Figures [Figure 18 (S51)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 10 the gaming machine also includes a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective. These features and limitations are believed to also be described in the Figures [Figure 18 (S51)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 11, the gaming machine also includes a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective. These features and limitations are believed to also be described in the Figures [Figure 18 (S51)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 12, the gaming machine also include a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective. These features and limitations are believed to also be described in the Figures [Figure 18 (S51)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 13, the gaming machine also includes a prior cell effective means for making at least one of the cells of the matrix effective based on an effective

cell lottery. These features and limitations are believed to also be described in the Figures [Figure 17 (S41)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 14, the gaming machine also includes a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery. These features and limitations are believed to also be described in the Figures [Figure 17 (S41)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 15, the gaming machine also includes a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery. These features and limitations are believed to also be described in the Figures [Figure 17 (S41)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 16, the gaming machine also includes a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery. These features and limitations are believed to also be described in the Figures [Figure 17 (S41)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

Independent claim 17 recites a gaming machine that is believed to also be described in the Figures and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy. With regard to the cell shift unit shifting each symbol allocated to a cell within a peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch, please see Figure 16 (S33 and S34).

According to claim 18, the cell shift unit includes a loop shifting means for shifting each symbol within the peripheral group of cells so as to be allocated to an adjacent cell such that the shifted symbols form a loop. These features and limitations are believed to also be described in the Figures and specification text referenced above with respect

to claims 1 and 2, and according is not separately description to avoid unnecessary redundancy.

Independent claim 19 is directed to stored subroutine logic executed by the gaming machine CPU. The claimed stored logic is believed to also be described in the Figures and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy. With regard to the shifting of each symbol allocated to a cell belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to a user input, please see Figure 16 (S33 and S34).

Independent claim 20 is directed to a server, connectable via a communication line to gaming machines, adapted to perform a combination-making game, the combination-making game using a square matrix which contains a plurality of cells. The server includes (1) a symbol allocation unit for allocating a symbol of a plurality of predetermined symbols to each cell, wherein a combination of the symbols makes a winning combination, (2) a cell shift unit for shifting each symbol allocated to a cell belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch, (3) a lottery selection unit for selecting a symbol by a lottery after the shifting, (4) a collation unit for collating the selected symbol with the allocated symbols, and for making a cell effective if the symbol allocated to that cell matches the selected symbol, and (5) a disbursement unit for making a disbursement if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination. The server arrangement is described with reference to Figure 19 and pages 73, line 25, through 77, line 26, which should be read in conjunction with the Figures and specification text referenced above with respect to claim 1. With regard to the cell shift unit for shifting each symbol allocated to a cell belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch, please see Figure 16 (S33 and S34).

According to claim 23, the cell shift unit includes (i) an outer peripheral cell shift portion for shifting each symbol of the outer peripheral group of cells, in response to pressing of a first switch, and (2) an inner cell shift portion for shifting each symbol of an inner group of cells from an inner original cell position to an inner adjacent cell position, in response to pressing of a second switch [see Figure 8A-8C, and page 55, lines 3-21].

According to claim 24, the symbol allocation unit allocates the predetermined symbols so as to allocate at least one winning combination of symbols to the cells forming at least one line, and to allocate other symbols to other cells. These features and limitations are believed to also be described in the Figures and specification text referenced above with respect to claim 2, and according is not separately description to avoid unnecessary redundancy.

According to claim 25, the gaming machine also includes a valid line determination unit for determining a number and locations of lines of the cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective. These features and limitations are believed to also be described in the Figures [Figure 18 (S51)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

According to claim 26, the gaming machine also includes a prior cell effective unit for making at least one of the cells of the matrix effective based on an effective cell lottery. These features and limitations are believed to also be described in the Figures [Figure 18 (S51)] and specification text referenced above with respect to claim 1, and according is not separately description to avoid unnecessary redundancy.

VI. GROUNDS FOR REJECTION PRESENTED FOR REVIEW

- 1) The rejection of claims under 35 U.S.C. §112, 2nd paragraph, as indefinite;
and
- 2) The rejection of claims under 35 U.S.C. §103(a) as obvious.

VII. BRIEF DESCRIPTION OF THE REFERENCES

The applied Barrie (US Patent 5,980,384), in relevant part, discloses that a primary game is performed independent of a secondary game, and the secondary game is performed dependent on the primary game (See, for example, the Abstract).

In column 1, lines 29-35, column 4, lines 12-43 and 52-68, and column 6, lines 13-28, Barrie discloses that some of the secondary game symbols are automatically changed from the original secondary game symbols to symbols used in the primary game, and that the primary game symbols are not changed. It is perhaps worthwhile to emphasize that, in Column 4, lines 53-60, Barrie explicitly discloses that the described change of symbols in the secondary game is performed automatically, and in column 6, lines 13-23 the Barrie disclosure relates to the results of a selection lottery.

More particularly, in column 4, lines 52-68, and column 6, lines 13-23, Barrie discloses:

“After each play of the primary game the game symbol appearing in each of the secondary game positions 126a,e,i,d,h,l along the far left and far right vertical edges of playing field 113 will automatically change to match the game symbols that appear in the adjacent one of primary game display positions 120a,b,c,g,h,i unless the symbol in one of these primary game display positions is the Flip-Flop symbol 132. This is done in accordance with one of the features of the invention wherein primary game symbols move to secondary game display positions. When the Flip-Flop symbol 132 appears in any of primary game positions 120a-i after each play of the primary game, the symbol appearing in horizontally adjacent ones of secondary game symbol display positions 126a-l will remain what they were before the spin, and will not change to a Flip-Flop symbol 132.” (col. 4: 52-68)

“Between spins or plays of the primary game the secondary game symbols remain in the secondary game positions 126a-126l except for automatic or manual secondary game symbol replacement/transpositions as described above. When a

player achieves four alike secondary game symbols, which may include wild card Jokers, in one or more of pay lines 121a, 121b and 121c, there is a win or wins for the secondary game. The operation described for the secondary game provides persistence of secondary game symbols over many plays of the primary game in accordance with another feature of the invention.” (col. 6: 13-23)

Thus, as described in the referenced text, Barrie discloses changing symbols in one (i.e. a secondary) game to those in another (i.e. a primary) game. That is, Barrie changes symbols from those of the applicable game to those of another different game.

In column 5, line 21, through column 6, line 12, Barrie discusses a Flip Flop function, which, as the name suggests, transpositions (i.e. switches the positions of) two symbols (i.e. each of the two symbols is moved to the other's prior position. function, which, as the name suggests, transpositions (i.e. switches the positions of) two symbols (i.e. each of the two symbols is moved to the other's prior position). It is worthwhile to note that according to Barrie, “[d]uring each play of the primary game the Flip-Flop symbol 132 can only appear in one primary game position at a time of each of horizontal game reels 119a,b,c”. (see column 5, lines 27-30) Additionally, Barrie also discloses:

“While transposition of secondary game symbols, as described immediately above, is done automatically, the game may also be configured such that decisions to transpose the secondary game symbols are made manually to permit a player to exercise their "optimizing skills" in accordance with one of the features of my invention. When the manual operation is provided the system utilizes touch screen technology and the player may affect the transposition by either pressing a button (not shown) on the gaming unit located below the display screen 112 (not shown), and there is one button positioned below each of game reels 119a,b,c; or the touch screen technology can be utilized and the player touches a displayed Flip-Flop symbol 132 to affect the transposition of the secondary game symbols on either side of the Flip-Flop symbol 132. In this manual operation Flip-Flop symbols in the primary game are used as soft buttons

to affect transposition of symbols in the secondary game, which is one of the features of the present invention.” (see column 5, line 61, through column 6, line 12)

In column 12, lines 36-55, Barrie summarily describes the shifting of symbols from one game to another. Barrie itself acknowledges in this text that what is described is also described elsewhere in the specification disclosure in greater detail.

VIII. THE REJECTION

In the final Official Action issued on December 13, 2007:

Claims 13-16 stand rejected under 35 U.S.C. §112, 2nd paragraph, as indefinite; and

Claims 1-27 stand rejected under 35 U.S.C. §103(a) as obvious over the applied Barrie (US Patent 5,980,384).

IX. ARGUMENT

Appellants respectfully traverse the rejections finally applied against the claims now pending on appeal. As discussed below in detail, it is respectfully submitted that the Examiner has not met the burden of proof in establishing that the appealed claims are either *prima facie* indefinite or *prima facie* obvious. The Examiner has also failed to apply prior art which can reasonably be construed to teach or suggest the claimed invention.

Definiteness of Claims 13-16

In the final Official Action, claims 13-16 stand rejected under 35 U.S.C. §112, 2nd paragraph, as indefinite.

This rejection was not asserted prior to the final Official Action. The rejection was traversed, and arguments rebutting the asserted grounds for rejection were presented, in the above referenced Request for Reconsideration. However, the rejection was not addressed in the subsequent Advisory Action. Accordingly, it is

unclear whether or not the rejection has been withdrawn or maintained in view of the arguments presented in the Request for Reconsideration.

If the event the rejection is maintain, it is respectfully submitted that the Examiner provided no persuasive objective evidence or explanation of why a person of ordinary skill in the art would not fully comprehend both the meaning and scope of each of the rejected claims and has, therefore, failed to establish a *prima facie* case of indefiniteness.

In support of the rejection, the final Official Action asserts:

“All of the said claims seem narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The examiner cannot understand or grasp the main idea within the many limitations of the claims.

Claims 13-16, states ‘The gaming machine according to Claim 1, further comprising: a prior cell effective means for making at least one of the cells of the matrix effective based on effective cell lottery.’ wherein the examiner cannot comprehend limitations the claims is trying to make, thus all of the claims are given broadest reasonable claim interpretation. The stated claims language above is just an example of indefinite claim language through out the claims. Appropriate correction is required.”

The failure to comprehend limitations the claims 13-16 is not understood.

Each of claims 13-16 requires “a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery.”

Details of this feature are described on page 69, first full paragraph, with reference to Figure 17. As described therein a prior cell effective means [a CPU executing a subroutine (see page 59, first full paragraph)] determines which of the cells of the matrix are to be effective from the start of the game [the means is characterized as a “prior cell effective means” (emphasis added) to make clear that the cells are made effective by the recited means prior to the start of the game].

The Court of Appeals for the Federal Circuit has quite recently stated that “the

specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a [] term'," and that "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." The Chamberlain Group, Inc., et al., v. Lear Corporation, Fed. Circ. No. 2007-1314, 1467, February 19, 2008.

It is respectfully submitted that each of claims 13-16 particularly point out and distinctly claim what the applicant regards as the invention and that those skilled in the art, having reviewed the specification, would fully comprehend both the meaning and scope of each of these claims.

Non-Obviousness of Claims 1-27 Over the Prior Art

It is respectfully submitted that the Examiner has provided no persuasive explanation why a person of ordinary skill in the art would have had reason to modify the prior art in a way that would result in the claimed invention and has, therefore, failed to establish a *prima facie* case of obviousness or to apply prior art which suggest that which the claimed invention.

Statement of Law

In rejecting claims under 35 U.S.C. 103, it is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). . In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins &

Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

The Supreme Court, in KSR International Co. v. Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007), has recently reaffirmed the familiar framework for determining obviousness as set forth in Graham v. John Deere Co (i.e. after the claim terms have been properly construed, obviousness is determined by (i) determining the scope and content of the prior art, (ii) ascertaining the differences between the claimed invention as properly construed and the prior art, (iii) resolving the level of ordinary skill in the pertinent art, and (iv) evaluating other objective evidence (secondary considerations), if any, relevant to the obviousness determination, such as evidence of commercial success, long felt but unsolved need, the failure of others, and unexpected results).

The reason why one would have been led to modify the prior art reference to arrive at the claimed invention must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior

art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 208 USPQ 817 (CCPA 1981).

The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F.2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F.2d 1392, 187 USPQ 481 (CCPA 1975).

Obviousness can only be considered after the scope of the claimed invention has been clearly determined by giving the claims the "broadest reasonable interpretation consistent with the specification." (emphasis added) See Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP §2111. That is, the scope of claims in patent applications is not determined solely on the basis of the claim language. Rather, claims must be given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." (emphasis added) In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

Of course, "reading a claim in light of the specification, to thereby interpret

limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim," and thus care must be taken to interpret the claims consistent with the specification's teachings without adding disclosed limitations which have no express basis in the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The PTO must apply "to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." (emphasis added) In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). The broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Accordingly, "[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." In re Marosi, 710 F.2d 799 at 802, 218 USPQ 289 at 292 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). When interpreting a claim term which is ambiguous one "must look to the specification for the meaning ascribed to that term by the inventor." In re Weiss, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993) (unpublished decision cited in MPEP 2111.01).

It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most

consistent with the use of the words by the inventor. Ferguson Beauregard/Logic Controls v. Mega Systems, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003). A term should be given its broadest reasonable interpretation consistent with the intrinsic record and take on the ordinary and customary meaning attributed to it by those of ordinary skill in the art. (emphasis added) ACTV, Inc. v. The Walt Disney Company, 346 F.3d 1082, 1092, 68 USPQ2d 1516, 1524 (Fed. Cir. 2003). The ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." Phillips v. AWH Corp., 415 F.3d at 1314, 75 USPQ2d at 1327. If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. Brookhill-Wilk 1, 334 F. 3d at 1300, 67 USPQ2d at 1137. "Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings." (emphasis added) Renishaw PLC v. Marposs Societa" per Azioni, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998).

The Board itself has recently cautioned that although "[t]he US Supreme Court recently held that rigid and mandatory application of the 'teaching-suggestion-motivation,' or TSM, test is incompatible with its precedents...[t]he Court did not discard the TSM test completely; it noted that its precedents show that an invention 'composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art'...The Court held that the TSM test must be applied flexibly, and take into account a number of factors 'in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed'...Despite this flexibility, however, the Court stated that 'it can be important to identify a reason that would have prompted a person of ordinary skill in the

relevant field to combine the [prior art] elements in the way the claimed new invention does ‘...’To facilitate review, this analysis should be made explicit’...The obviousness rationale addressed in KSR was premised on combining elements known in the prior art...The KSR court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some ‘apparent reason to combine the known elements in the fashion claimed’.” Ex Parte Thomas J. Whalen II, et al., BPAI Appeal No. 2007-4423, July 23, 2008.

Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

Arguments

Independent Claims 1, 3, 17, 19, and 20 – The making effective of cells after allocation and shifting of symbols and the making of a disbursement if the cells made effective along a line have a winning combination of symbols

The limitations of each of the independent claims require that there be (i) an allocation of symbols to cells, (ii) a shifting of the allocated symbols, (iii) a making effective of cells with allocated symbols by lottery and after the shifting, and (iv) making a disbursement if the cells along a line having a winning combination and having been made effective.

Stated another way, each of the independent claims (i.e. each of claims 1, 3, 17, 19, and 20) of the present application requires the capability to:

- (i) allocate symbols for a game to cells,
- (ii) shift the allocated symbols among the cells,

(iii) after shifting, make cells with allocated symbols effective by lottery,
and

(iv) make a disbursement if the cells made effective along a line have a winning combination of symbols.

It is respectfully submitted that Barrie, on the other hand, discloses a slot machine in which an allocated symbol is always effective (every symbol on a slot machine reel always has the potential to be part of the symbols forming a winning combination throughout the game, whereas in accordance with the present invention a symbol in a cell of the matrix does not have the potential to be part of the symbols forming a winning combination unless the cell is first made effective during play of the game). To the extent Barrie can be considered to allocate symbols to cells (which is not admitted), in the context of the claimed invention, the allocation of the symbol to the cell makes the cell effective. Barrie lacks any disclosure of making effective cells that already have symbols.

Accordingly, Barrie necessarily fails to teach or suggest a disbursement based on the cells along a line having a winning combination and having been made effective by lottery after shifting symbols, as required by each of the independent claims.

The above referenced Advisory Action further asserts that “Barrie teaches of a gaming machine (slot machine), wherein symbols are allocated to each cell on a multi-cell gaming machine, wherein the symbol is selected randomly (col. 4: 29-43)... The game machine consists of a number generator that randomly places a symbol into each cell of the machine (col. 4: 29-43, col. 1: 29-35).”

However, the claims do not require that symbol allocated to each cell be a randomly selected symbol, but rather that cells with allocated symbols be made effective by lottery.

Independent Claims 1 and 3 - The Shifting of Symbols

Independent claims 1 and 3 require the capability to shift each allocated symbol

of a peripheral group of cells of the matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells.

The final Official Action contends that “Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23).”

However, in the referenced text Barrie discloses:

“After each play of the primary game the game symbol appearing in each of the secondary game positions 126a,e,i,d,h,l along the far left and far right vertical edges of playing field 113 will automatically change to match the game symbols that appear in the adjacent one of primary game display positions 120a,b,c,g,h,i unless the symbol in one of these primary game display positions is the Flip-Flop symbol 132. This is done in accordance with one of the features of the invention wherein primary game symbols move to secondary game display positions. When the Flip-Flop symbol 132 appears in any of primary game positions 120a-i after each play of the primary game, the symbol appearing in horizontally adjacent ones of secondary game symbol display positions 126a-l will remain what they were before the spin, and will not change to a Flip-Flop symbol 132.” (col. 4: 52-68)

“Between spins or plays of the primary game the secondary game symbols remain in the secondary game positions 126a-126l except for automatic or manual secondary game symbol replacement/transpositions as described above. When a player achieves four alike secondary game symbols, which may include wild card Jokers, in one or more of pay lines 121a, 121b and 121c, there is a win or wins for the secondary game. The operation described for the secondary game provides persistence of secondary game symbols over many plays of the primary game in accordance with another feature of the invention.” (col. 6: 13-23)

Thus, the referenced text of Barrie discloses changing symbols in one (i.e. a

secondary) game to those in another (i.e. a primary) game.

The referenced text of Barrie lacks any disclosure whatsoever of shifting (rather than changing) symbols allocated to cells of a matrix, let alone shifting symbols allocated to cells in a single game (not between different games).

Furthermore, one can only ask, where in the referenced text it is contended that Barrie teaches or otherwise suggests shifting allocated symbols of a peripheral group of cells of a matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells? As described in the referenced text, Barrie changes symbols from those of the applicable game to those of another different game, and hence has no need to consider a “peripheral group of cells” or moving symbols from “an original cell position to an adjacent cell position” or moving symbols “such that a loop of allocated symbols are shifted along the peripheral group of cells”.

In column 5, line 21, through column 6, line 12, Barrie does discuss a Flip Flop function, which, as the name suggests, transpositions (i.e. switches the positions of) two symbols (i.e. each of the two symbols is moved to the other’s prior position).

However, even assuming, for the sake of argument, that such a transposition can be properly considered to correspond to a shifting of symbols, Barrie still lacks any teaching or suggestion that the disclosed transformation should or could beneficially shift allocated symbols of a peripheral group of cells of a matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells, as required by claims 1 and 3. Indeed, to modify Barrie to include such limitations would change a principle of operation of Barrie’s invention (See *In re Ratti*, 270 F.2d 810, 123 USPQ 349, CCPA 1959).

The above referenced Advisory Action further asserts:

(1) “...it is noted that the features upon which applicant relies (i.e. loop of allocated symbols are shifted along the peripheral groups of cells) are not recited in the rejected claim(s).”

However, claims 1 and 3, in fact, explicitly recite these features.

(2) “Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68)”.

However, this fails to address the fact that the shifting disclosed by Barrie is a shifting of symbols between two different games.

The Examiner additionally asserts that “Regarding the applicant's arguments that Barrie lacks any teaching or suggestion that discloses transformation should shift each symbol allocated to a cell within or belonging to a peripheral group of cells. The examiner disagrees with the applicant. As stated in the previous rejection Barrie, teaches of shifting each cell symbol to an adjacent cell within a peripheral group of cells (in col. 12: 36-55 as well as the other cited paragraphs in the rejection clearly teach of moving symbol from an original position to an end position and providing the players awards based on the bets made by the player).”

However, the reference to column 12, lines 36-55, of Barrie (which is first cited in the Advisory Action) does not cure the defects in the position asserted in the final Official Action, as discussed in detail above. Indeed, the newly cited text is a summary description related to the shifting of symbols from one game to another. Barrie itself acknowledges in this newly cited text that what is described is also described elsewhere in the specification disclosure in greater detail.

Independent Claims 17 and 20 - The Shifting of Symbols

Independent claims 17 and 20 require the capability to shift each symbol allocated to a cell within or belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch.

The final Official Action contends that “Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23).”

However, as discussed in more detail above with reference to claims 1 and 3, the referenced text of Barrie teaches only the changing of symbols from those of the applicable game to those of another different game and lacks any teaching or suggestion of shifting symbols.

As also discussed above, in column 5, line 21, through column 6, line 12, Barrie does discuss a Flip Flop function, which, as the name suggests, transpositions (i.e. switches the positions of) two symbols (i.e. each of the two symbols is moved to the other's prior position). It is worthwhile to note that according to Barrie, "[d]uring each play of the primary game the Flip-Flop symbol 132 can only appear in one primary game position at a time of each of horizontal game reels 119a,b,c" (see column 5, lines 27-30). Additionally, Barrie also discloses"

"While transposition of secondary game symbols, as described immediately above, is done automatically, the game may also be configured such that decisions to transpose the secondary game symbols are made manually to permit a player to exercise their "optimizing skills" in accordance with one of the features of my invention. When the manual operation is provided the system utilizes touch screen technology and the player may affect the transposition by either pressing a button (not shown) on the gaming unit located below the display screen 112 (not shown), and there is one button positioned below each of game reels 119a,b,c; or the touch screen technology can be utilized and the player touches a displayed Flip-Flop symbol 132 to affect the transposition of the secondary game symbols on either side of the Flip-Flop symbol 132. In this manual operation Flip-Flop symbols in the primary game are used as soft buttons to affect transposition of symbols in the secondary game, which is one of the features of the present invention."

However, even assuming, for the sake of argument, that such a manual transposition can be properly considered to correspond to a shifting of symbols in response to operation of a switch, Barrie still lacks any teaching or suggestion that the disclosed transformation should or could beneficially shift each symbol allocated to a

cell within or belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to such switch operation. Here again, to modify Barrie to include such limitations would change a principle of operation of Barrie's invention. This is because Barrie explicitly discloses that "the Flip-Flop symbol 132 can only appear in one primary game position at a time of each of the horizontal game reels 119a,b,c."

Independent Claims 17 and 20 - Lottery Selection, Collation and Disbursement Units

Furthermore each of claims 17 and 20 requires a lottery selection unit for selecting a symbol by lottery after the shifting (step S14 of Fig.14 and step S42 of Fig.17), a collation unit for collating the selected symbol with the allocated symbols and for making a cell effective if the symbol allocated to that cell matches the selected symbol (step S43 of Fig.17), and a disbursement unit for making a disbursement if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination (step S15 of Fig.14 and Fig.18).

As is believe to be clear from the above discussion, although Barrie executes the spinning of reels (119a-119c, 219a-219e), it lacks any teaching or suggestion of a lottery selection of effective cells after a shifting of symbols, or of execution of collation, or of disbursement if the cells along a line are made effective and the symbols then allocated (i.e. after the shift) to the effective cells make a winning combination.

Independent Claim 19 – The Shifting of Symbols

Independent claim 19 requires the capability to shift each symbol allocated to a cell belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to a user input.

The final Official Action contends that "Barrie also teaches of shifting symbols from original cell to an adjacent cell position (col. 4: 52-68). Barrie also teaches of an award determination means, which determines the award, and disburses, to the player if

any combination of symbols is achieved after the occurrence of the shift (col. 6: 13-23).”

However, as discussed in more detail above with reference to claims 1 and 3, the referenced text of Barrie teaches only the changing of symbols from those of the applicable game to those of another different game and lacks any teaching or suggestion of shifting symbols.

As also discussed above, in column 5, line 21, through column 6, line 12, Barrie does discuss a Flip Flop function, which, as the name suggests, transpositions (i.e. switches the positions of) two symbols (i.e. each of the two symbols is moved to the other's prior position).

However, as discussed in greater detail above with reference to claims 17 and 20, even assuming, for the sake of argument, that such a manual transposition can be properly considered to correspond to a shifting of symbols in response to a user input, Barrie still lacks any teaching or suggestion that the disclosed transformation should or could beneficially shift each symbol allocated to a cell within or belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to such an input. Here again, to modify Barrie to include such limitations would change a principle of operation of Barrie's invention.

Independent Claim 19 - Lottery Selection, Collation and Disbursement

Furthermore claim 19 requires selecting a symbol by lottery after the shifting, collating the selected symbol with the allocated symbols, making a cell effective if the symbol allocated to that cell matches the selected symbol, and making a disbursement if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination.

As shown in Fig.14, the preparation of a matrix is performed (step S12), and the setting of the betting quantity is performed (step S13). Further to the preparation, the game is executed (step S14), with a lottery selection of symbols being performed a predetermined number of times. After the execution of the game, the payment of coins

is performed (step S15).

As shown in Fig.17, a lottery selection of a symbol is performed (step S42) as described on page 69. In this process, one symbol is selected by an internal lottery. The selected symbol is then displayed in the list of lottery results displayed at the upper right part of display device 32, as shown in Fig.11. If the selected symbol has already been selected once in the same game and is displayed in the above-mentioned list, the lottery result is not displayed a second time and the lottery is performed again so that a new symbol will be selected. Next, collation of the symbol is performed (step S43), as described in page 69. In this process, CPU 66 collates the above selected symbol with the symbols displayed in the matrix. If the same symbol as the selected symbol is displayed in the matrix, the cell in which the symbol is displayed is made effective and the color of this cell is changed, as shown in Fig.11.

As shown in Fig.18, a judgment is made as to whether or not there is a winning line (step S51) as described in pages 70-71. To do so, it is judged whether or not a line, in which all cells have been made effective and a winning combination is formed, exists among the combinations of symbols along the plurality of lines in the matrix displayed on display device 32. If it is judged that there is a winning line among the plurality of lines, a predetermined benefit is provided to the player.

Again, as is believed to be clear from the above discussion, although Barrie executes spinning of reels (119a-119c, 219a-219e), it lacks any teaching or suggestion of a lottery selection of cells after a shifting of symbols, or of execution of collation, or of disbursement if the cells along a line are made effective and the symbols then allocated (i.e. after the shift) to the effective cells make a winning combination.

Dependent Claims 2, 4, and 18

Each of claims 2, 4, and 18 require the capability to shift each allocated symbol of an inner group of cells of the matrix from an inner original cell position. Thus, the capability to shift symbols in outer and inner cell groups is required.

The final Official Action references Figure 2 of Barrie in support of the rejection of these claims. However, as pointed out in the above reference Request for Reconsideration, the reference to Figure 2 is not understood. Indeed, it is entirely unclear how it is contended that Figure 2 of Barrie discloses the required limitations. However, no further explanation was provided in the Advisory Action. Thus, it appears that these limitations have been overlooked in the rejection.

Dependent Claims 5-8 and 24

Each of claims 5-8 and 24 require a symbol allocation means or unit capable of allocating the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along the peripheral group of cells and/or the inner group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard.

As shown in Fig.15, a lottery selection of a winning combination is performed (step S21). In this process, one winning combination is selected from among a stored winning combination list. Next, the selection of symbols used in the determined winning combination is performed (step S22). Next, the line along which the determined winning combination is to be aligned is selected (step S23). For example, a lottery selection can be performed to determine the line among the twelve lines of the matrix. Furthermore, the allocating of the symbols that make up the determined winning combination is performed (step S24). To do so, it is determined by lotteries which cells along the line should be allocated which of the symbols, so that each cell along the line has a respective symbol.

In addition, as shown in Fig.15, allocation of symbols to the remaining cells is performed (step S25). The symbols to be allocated to the remaining cells are also selected by lotteries, and the selected symbols are allocated to each of the remaining cells.

By carrying out the above, a plurality of matrices having at least one winning

combination is easily prepared. In addition, it is possible to prevent a player from receiving a matrix with which a winning combination cannot be formed at all.

Accordingly, the player can anticipate receiving a benefit.

The final Official Action asserts (only with respect to claims 5-8) that “Barrie discloses of multiple paylines, which are player selectable (col. 6: 24-28). Barrie also teaches obtaining winning combination after the symbols have been allocated and determining that the benefits provided to the players in the bonus round or after the symbol allocation is higher than standard payout (col. 4: 52-68 and figure 2 and description thereof).”

However, this claim is not simply directed to multiple pay lines or obtaining a winning combination after symbols have been allocated or paying a higher payout in a bonus round. Thus, it appears that limitations have also been overlooked in this rejection. Thus, it is entirely unclear how it is contended that the referenced text and Figure 2 of Barrie discloses the required limitations.

Dependent Claims 9-12 and 25

Each of claims 9-12 and 25 require a valid line determination means or unit for determining a number and locations of lines of cells with respect to which disbursement of game media may be carried out if all cells aligned therein become effective.

The final Official Action asserts (only with respect to claims 9-12) that “Barrie discloses of a combination recognition means, which determines if the combination on the screen results in an award, and if so then provides an award to the player (col. 4: 12-28).”

However, as pointed out in the above reference Request for Reconsideration, these claims are not directed to a “combination recognition means, which determines if the combination on the screen results in an award”, but rather to a means for determining a number and locations of lines of cells that, if effective, will result in a disbursement of game media. The rejection was not further clarified in the Advisory

Action. Thus, it also appears that limitations have been overlooked in this rejection.

Dependent Claims 13-16 and 26

Each of claims 13-16 and 26 require a prior cell effective means or unit for making at least one of the cells of the matrix effective based on an effective cell lottery.

As shown in Fig.17, the determination of a prior effective cell is performed (step S41). To do so, a lottery is performed to determine a cell to be made effective from the start of the game, and the cell is made effective prior to the start of the game.

In accordance with the present invention, the positions of the symbols are determined in advance, unlike in the original “poker game”. So, there is the possibility that a large number of lotteries will be required to complete a line.

Thus, with the invention of claims 13-16, some portion of the cells are made effective by a lottery in advance of the game, and this shortens the game time. Also a player can anticipate earlier completion of a line, thereby making it more likely to draw the interest of the player.

In addition, because in the case where the designs of “mahjong tiles” are used, the number of cells can become large. The invention of claims 13-16 enables faster progress to be made in playing the game.

The final Official Action asserts (only with respect to claims 13-16) that “Barrie discloses of a prior cell effective means for making on of the cells of the matrix in accordance with an effective lottery (col. 6: 13-23).”

However, as pointed out in the above reference Request for Reconsideration, each of these claims require an effective cell lottery in addition to the selection lottery recited in its parent claim (which serves as a subsequent effective cell lottery). The referenced Barrie disclosure relates to the results of a symbol selection lottery to determine which symbols will form the combination that will determine the outcome of the game. The rejection was not further clarified in the Advisory Action. Thus, it appears that limitations have also been overlooked in this rejection.

Dependent Claim 23

Dependent claim 23 requires that the cell shift unit includes (i) an outer peripheral cell shift portion for shifting each symbol of the outer peripheral group of cells, in response to pressing of a first switch, and (ii) an inner cell shift portion for shifting each symbol of an inner group of cells from an inner original cell position to an inner adjacent cell position, in response to pressing of a second switch.

Claim 23 requires the capacity to shift symbols in inner cells and to shift symbols in outer cells and therefore, for the reasons discussed above with regard to dependent claims 2, 4, and 18, the final Official Action also fails to establish a *prima facie* case for the obviousness rejection of this claim.

Furthermore, claim 23 requires that the cell shift unit be capable of shifting symbols in the inner cells responsive to the pressing of one switch, and of shifting symbols in the inner cells responsive to the pressing of another second switch. However, these limitations are not addressed at all in the final Official Action or the subsequent Advisory Action. Hence, one can only conclude that these limitations have been completely ignored.

In view of the above, it is respectfully submitted that the Examiner has failed to establish a *prima facie* basis for the obviousness rejection of the above identified claims and hence has also failed to apply prior art that can be reasonable construed to suggest the above identified limitations of the claimed invention

As discussed in detail above, the appealed claims have been rejected based on a misconstruction of the claim terms. The prior art cited in support of the rejections has been applied in a manner inconsistent with its own teachings. Express limitations set forth in the claims have been effectively ignored. The evidence shows that there is nothing in the applied prior art to support the Examiner's position that the present claims are obvious. Hence, at best, it can only be concluded that the rejection of the claims

Docket No: 3022-016
Applicants Ref: P02-0131US
Client No.: ARF-027US
File No.: 1227.42952X00

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reflects an improper hindsight reconstruction of the invention based on the teachings of the subject application itself.

CONCLUSION

It is respectfully submitted that the Examiner (i) has failed to present evidence or a rationale that prima facie establishes that claims 13-16 are indefinite under 35 U.S.C. §112, 2nd paragraph, or that claims 1-27 are obvious under 35 U.S.C. §103(a), and (ii) has failed to apply art which teaches or suggests the claimed invention. Indeed, explicitly recited limitations in the claims have been actually or effectively ignored. At best improper hindsight has been used to reconstruct the invention using the inventors own disclosure as a guide. Thus, the rejection of the pending claims either as indefinite under 35 U.S.C. §112, 2nd paragraph, or as obvious under 35 U.S.C. §103(a) over the applied prior art, is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 (Case No. 1227.42952X00) and please credit any excess fees to such deposit account.

Respectfully Submitted,

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APPENDIX A
CLAIMS UNDER APPEAL

1. (Previously Presented) A gaming machine with which a combination-making game is performed, the combination-making game using a matrix which comprises five rows and five columns so as to contain a plurality of cells, wherein a symbol is allocated to each cell, and a cell becomes effective when a symbol corresponding to the cell is selected randomly by a lottery, and a predetermined benefit is provided to a player based on a pattern of cells being effective after a predetermined number of lotteries, the gaming machine comprising:

a symbol allocation means for allocating a symbol to each cell of the matrix, the symbol being selected from a deck of playing cards;

an outer peripheral cell shift means for shifting each allocated symbol of a peripheral group of cells of the matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells; and

a disbursement value determination means for determining an amount of disbursement or a multiple of a number of bets made by the player for disbursement depending on a predetermined rank of a combination of the combination-making game, if all cells along a line become effective after a predetermined number of lotteries and the symbols allocated to the respective cells along the line make a winning combination in a poker game.

2. (Previously Presented) The gaming machine according to Claim 1, further comprising:

an inner peripheral cell shift means for shifting each allocated symbol of an inner group of cells of the matrix from an inner original cell position to an inner adjacent cell position such that an inner loop of allocated symbols are shifted along the inner group of cells.

3. (Previously Presented) A gaming machine with which a combination-making game is performed, the combination-making game using a matrix which comprises a plurality of rows and a same number of columns so as to contain a plurality of cells, wherein a symbol is allocated to each cell, and a cell becomes effective when a symbol corresponding to the cell is selected randomly by a lottery, and a predetermined benefit is provided to a player based on a pattern of cells being effective after a predetermined number of lotteries, the gaming machine comprising:

a symbol allocation means for allocating a symbol to each cell of the matrix, the symbol being selected from a set of mahjong tiles;

an outer peripheral cell shift means for shifting each allocated symbol of a peripheral group of cells of the matrix from an original cell position to an adjacent cell position such that a loop of allocated symbols are shifted along the peripheral group of cells; and

a disbursement value determination means for determining amount of disbursement or a multiple of a number of bets made by the player for disbursement depending on a predetermined rank of a combination of the combination-making game, if all cells along a line become effective after a predetermined number of lotteries and the symbols allocated to the respective cells along the line make a winning combination in a poker game.

4. (Previously Presented) The gaming machine according to Claim 3, further comprising:

an inner peripheral cell shift means for shifting each allocated symbol of an inner group of cells of the matrix from an inner original cell position to an inner adjacent cell position such that an inner loop of allocated symbols are shifted along the inner group of cells.

5. (Previously Presented) The gaming machine according to Claim 1, wherein said symbol allocation means allocates the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along the peripheral group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard.

6. (Previously Presented) The gaming machine according to Claim 2, wherein said symbol allocation means allocates the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along at least one of the peripheral group of cells and the inner group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard.

7. (Previously Presented) The gaming machine according to Claim 3, wherein said symbol allocation means allocates the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along the peripheral group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard.

8. (Previously Presented) The gaming machine according to Claim 4, wherein said symbol allocation means allocates the symbols to the cells of the matrix such that at least one winning combination of symbols will be in at least one line of cells after a shift of allocated symbols along at least one of the peripheral group of cells and the inner group of cells, so that the predetermined benefit provided to the player will exceed a predetermined standard.

9. (Previously Presented) The gaming machine according to Claim 1, further comprising:

a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective.

10. (Previously Presented) The gaming machine according to Claim 2, further comprising:

a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective.

11. (Previously Presented) The gaming machine according to Claim 3, further comprising:

a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective.

12. (Previously Presented) The gaming machine according to Claim 4, further comprising:

a valid line determination means for determining a number and locations of lines of cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective.

13. (Previously Presented) The gaming machine according to Claim 1, further comprising:

a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery.

14. (Previously Presented) The gaming machine according to Claim 2, comprising:

a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery.

15. (Previously Presented) The gaming machine according to Claim 3, comprising:
a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery.

16. (Previously Presented) The gaming machine according to Claim 4, comprising:
a prior cell effective means for making at least one of the cells of the matrix effective based on an effective cell lottery.

17. (Previously Presented) A gaming machine adapted to perform a combination-making game, the combination-making game using a square matrix which contains a plurality of cells, the gaming machine comprising:
a symbol allocation unit for allocating one of a plurality of predetermined symbols to each cell, wherein a combination of the predetermined symbols makes a winning combination;
a cell shift unit for shifting each symbol allocated to a cell within a peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch;
a lottery selection unit for selecting a symbol by a lottery after shifting the symbols;
a collation unit for collating the selected symbol with the allocated symbols, and for making a cell effective if the symbol allocated to that cell matches the selected symbol; and
a disbursement unit for making a disbursement, if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination.

18. (Previously Presented) The gaming machine according to Claim 17, wherein said cell shift unit comprises a loop shifting means for shifting each symbol within the peripheral group of cells so as to be allocated to an adjacent cell such that the shifted symbols form a loop.

19. (Previously Presented) An article of manufacture comprising a program stored on medium for use in a gaming machine to perform a combination-making game, the combination-making game using a square matrix which contains a plurality of cells, wherein execution of the program by the gaming machine causes the gaming machine to:

- allocate a symbol of a plurality of predetermined symbols to each cell, wherein a combination of the predetermined symbols makes a winning combination;

- shift each symbol allocated to a cell belonging to a peripheral group of cells from an original cell position to an adjacent cell position, in response to a user input;

- select a symbol by a lottery after the shift of the symbols;

- collate the selected symbol with the allocated symbols, and make a cell effective if the symbol allocated to that cell matches the selected symbol; and

- make a disbursement, if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination.

20. (Previously Presented) A server, connectable via a communication line to gaming machines, adapted to perform a combination-making game, the combination-making game using a square matrix which contains a plurality of cells, the server comprising:

- a symbol allocation unit for allocating a symbol of a plurality of predetermined symbols to each cell, wherein a combination of the symbols makes a winning combination;

- a cell shift unit for shifting each symbol allocated to a cell belonging to a

peripheral group of cells from an original cell position to an adjacent cell position, in response to operation of a switch;

a lottery selection unit for selecting a symbol by a lottery after the shifting;

a collation unit for collating the selected symbol with the allocated symbols, and for making a cell effective if the symbol allocated to that cell matches the selected symbol; and

a disbursement unit for making a disbursement if the cells along a line are made effective, and the symbols allocated to the effective cells along the line make a winning combination.

21. (Previously Presented) The gaming machine according to claim 17, wherein:

the square matrix includes five rows and five columns;

the symbol is selected from a deck of playing cards; and

the winning combination is determined in a poker game.

22. (Previously Presented) The gaming machine according to claim 17,

wherein the symbol is selected from a set of mahjong tiles.

23. (Previously Presented) The gaming machine according to claim 17, wherein the cell shift unit includes:

an outer peripheral cell shift portion for shifting each symbol of the outer peripheral group of cells, in response to pressing of a first switch;

an inner cell shift portion for shifting each symbol of an inner group of cells from an inner original cell position to an inner adjacent cell position, in response to pressing of a second switch.

24. (Previously Presented) The gaming machine according to claim 17, wherein the symbol allocation unit allocates the predetermined symbols so as to allocate at least

one winning combination of symbols to the cells forming at least one line, and to allocate other symbols to other cells.

25. (Previously Presented) The gaming machine according to claim 17, further comprising:

a valid line determination unit for determining a number and locations of lines of the cells, with respect to which disbursement of game media may be carried out if all cells aligned therein become effective.

26. (Previously Presented) The gaming machine according to claim 17, further comprising:

a prior cell effective unit for making at least one of the cells of the matrix effective based on an effective cell lottery.

27. (Previously Presented) The gaming machine according to claim 17, wherein the disbursement unit includes a disbursement calculation portion for calculating an amount of disbursement depending on a bet amount made by the player and a predetermined rank of the winning combination.

Docket No: 3022-016
Applicants Ref: P02-0131US
Client No.: ARF-027US
File No.: 1227.42952X00

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APPENDIX B

**PREVIOUSLY ENTERED AFFIDAVITS AND/OR DECLARATIONS UNDER RULES
130 (COMMONLY OWNED PRIOR ART), 131 (PRIOR INVENTION) AND/OR 132
(TRAVERSALS)**

NONE

Docket No: 3022-016
Applicants Ref: P02-0131US
Client No.: ARF-027US
File No.: 1227.42952X00

PATENT

APPENDIX C

BPAI AND COURT DECISIONS IN RELATED PROCEEDINGS

NONE

Docket No: 3022-016
Applicants Ref: P02-0131US
Client No.: ARF-027US
File No.: 1227.42952X00

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